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In re Application of	:	
Huang et al.	:	
Application No.: 10/511,236	:	DECISION
PCT No.: PCT/JP03/04563	:	
Int. Filing Date: 10 April 2003	:	ON
Priority Date: 11 April 2002	:	
Attorney Docket No.: F-8417	:	PETITION
For: Conversation Control System And	:	
Conversation Control Method	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 26 September 2005.

#### **BACKGROUND**

This international application was filed on 10 April 2003, claimed an earlier priority date of 11 April 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 16 October 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 12 October 2004 (since 11 October 2004 was a holiday). Applicants filed *inter alia* the basic national fee on 12 October 2004.

On 22 April 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(e).

#### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the petition was accompanied by the \$200.00 petition fee.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Dong Li be excused because allegedly he "cannot be found or reached after diligent effort." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR

1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Counsel alleges that a declaration, along with "the application documents (including specification, claims and drawings)" was "sent to Dong Li by certified mail on July 8, 2005 to Dong Li's last known address" but was undeliverable because Mr. Li "has moved from his last known address and did not leave a forwarding address." This account is corroborated by the accompanying "Declaration of Shin Nomura..." and supporting documentation. However, petitioner has not shown what diligent efforts if any were undertaken to locate Mr. Li after becoming aware that he had moved. For instance, did petitioner perform internet searches or telephone directory searches, or perform any other inquiries, to attempt to locate Mr. Li's current address? Since the instant petition does not establish that any efforts were undertaken to locate Mr. Li other than merely sending a single parcel to his last known address, it would not be appropriate to conclude that he "could not be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a). Hence, it would be inappropriate to conclude that requirement (2) has been satisfied at this time.

Regarding requirement (3), the petition includes a statement the last known addresses of Dong Li. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the petition is accompanied by a declaration signed by joint inventors Huang, Katukura and Wu on behalf of themselves and non-signing joint inventor Li. This declaration satisfies requirement (4).

#### **DECISION**

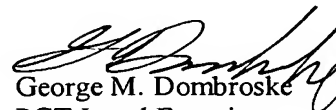
The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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